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Applicant :	Clemons et al	
Serial No. :	09/435,257	**Group Art Unit: 1632**
Filed :	November 5, 1999	**Examiner: P. Paras, Jr.**
For :	*FK506-Based Regulation of Biological Events*	

#51
9/21/00

Assistant Commissioner of Patents
Washington, DC 20231

September 5, 2000

Response to Restriction Requirement

Sir:

This paper is in response to the Office Action mailed August 3, 2000 in the above-identified application. A response to that Office Action is due, taking into account the preceding weekend and Federal holiday, on September 5, 2000. Accordingly, this response should be considered timely filed.

Traversal of Restriction Requirement

Claims 1-50 are pending and are subject to a 5-way restriction requirement. Applicants traverse that restriction requirement on the following rationale.

First, applicants traverse the restriction of claims 40 - 45 into Groups **III** and **IV**. Those claims involve multimerizing certain fusion proteins in cells. Especially because those fusion proteins include at least one of the distinctive, novel "CAB" fusion proteins of the invention, applicants view the search and examination of claims 40 - 45 as not unduly burdensome. Moreover, as noted by the examiner, there are no provisions in MPEP 806.05 requiring those claims be split into two groups. Indeed, the absence of a compelling reason to restrict, combined with the presence of bridging claims 40, 41 and 45, is sufficient in applicants' view to traverse the restriction.

Second, as to the restriction of Groups **I** and Groups **II-IV**, the Office Action expresses the view that the invention claimed in Group I (fusion protein) is unrelated to the inventions of Groups II-IV because the inventions are not disclosed as capable of use together and the

inventions have different modes of operation, function, etc. However, Groups **III** and **IV** are directed to methods for multimerizing fusion proteins, at least one of which is a fusion protein of claim 19. Thus, the inventions of Groups I and III and IV are in fact disclosed as capable of use together (see e.g. page 2, lines 1-3).

Likewise the inventions of Group **II** (method for introducing DNA into cells) and **V** (kits) were said to be inventions not disclosed as capable of use together and having different modes of operation, function, etc. Again, since the kits are disclosed as for use in conducting the genetic engineering method of Group II, the inventions are in fact disclosed as capable of use together, and again, that basis for restriction appears to be incorrect. See e.g. page 6 of the application, lines 13 *et seq.*, page 21, line 11 *et seq* and page 72, lines 19 *et seq*).

In view of the foregoing, applicants request that the restriction requirement be reconsidered.

In the interest of making a complete response, applicants elect Group II, but request that the search and examination be expanded to include Claims 1 - 18 and 20 - 33 and Claims 46 - 50 (Group V) as well. Applicants further request that upon a finding of patentable subject matter in those claims, and particularly in view of the distinctiveness of the CAB fusion proteins of this invention, nucleic acids encoding them and the various uses of the foregoing, that the search and examination be further extended to include the closely related subject matter of Groups I, III and IV.

Reconsideration and withdrawal, even partial withdrawal, of the restriction requirement is not thought to be unduly burdensome to the PTO, would avoid the multiplication of expense for a small entity assignee, and could lead to a more streamlined prosecution.

Respectfully submitted,

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Date September 5, 2000

I hereby certify that this paper is being deposited with the United States Postal Service via First Class Mail under 37 CFR 1.10 on the date indicated above and is addressed to Assistant Commissioner for Patents, Washington, DC 20231

Signed _____